

REMARKS

Parts of the specification were amended to include matter disclosed in the figures but not described in the specification. Figs. 1, 6 & 8 were also corrected to include missing reference numbers. Support for all of these changes are found in the specification, claims and figures, as originally filed. No new matter was added.

Claims 1-22 are pending in the above-identified application. Claim 23 is being added for the reasons outlined below.

Claims 1-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Edelson (U.S. Patent No. 4,985,952) in view of Dionne et al (U.S. Patent No. 5,645,494). With respect to Claims 1-22, the Examiner stated that the Examiner was incorporating the rejection from the previous office action.

In response, Applicant respectfully contends that the obviousness rejection under 35 U.S.C. § 103 cannot be established by combining the teachings of Edelson with Dionne as the rejection is inadequate to establish a *prima facie* case of obviousness. Applicant respectfully contends that the obviousness rejection under 35 U.S.C. § 103 cannot be established by combining the teachings of Edelson with Dionne but because not only is there is no suggestion or motivation in either of the cited references for modifying Edelson in the manner disclosed by Dionne, the references are neither in the same field of endeavor nor do they address the same problem.

The Office Action failed to address the individual elements of the claims, as is required by the MPEP. For example, in claim 1, the Office Action ignores that there is a symmetrical body placement guide that is

configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. While Edelson discloses a mat having an upper surface and a lower surface and four equal quadrants in a rectangular configuration adjacent to each other, the Office Action admits that Edelson fails to disclose a mirrored pattern in each quadrant or a body placement guide on the upper surface. Edelson states that the mattress disclosed in Edelson can be used as an exercise mat (see Abstract).

The rejections of Claims 1-22 were substantively and procedurally inadequate as the rejections failed to provide any basis for combining Edelson with Dionne et al. and also failed to show that the combined prior art references teach or suggest all claim limitations. With all due respect, the Office Action failed to provide any explanation as to what was the suggestion or motivation in the references rendering it obvious to use what is allegedly taught by Dionne et al. in combination with Edelson. The Office Action failed to set forth any reason as to why Edelson and Dionne should be combined. The Office Action failed to state whether the references were in the same field of endeavor or if they addressed solving the same problem. The Office Action failed to do so because the two references are neither in the same field of endeavor nor do they address the same problem. In response to Applicant's Arguments in response to the previous Office Action, the Examiner merely stated in a conclusory manner that:

Edelson can be used as an exercise mat [col. 1, lines 30 which serves the same purpose as a yoga mat for exercising.

However, the Office Action utterly failed to address the basis for combining Dionne et al. with Edelson. Even though Edelson can be used as

an exercise mat, there is nothing in Edelson that either explicitly or implicitly suggests the use of a body placement guide. Edelson addresses a generic multi-use mat upon which a human body can rest, sleep or use for exercise. Edelson failed to disclose the use of indicia, much less whether there was even any need for such indicia to be located on the mattress. The citation of Dionne is based on improper hindsight and thus may not form the basis of combining Edelson with Dionne. Dionne et al. is addressed specifically to golf mats. The Examiner cannot point to a single figure, column or line where it is suggested, explicitly or impliedly, that Dionne can be applied to a use other than for golf.

In Ruiz v A.B. Chance Co., 234 F.3d 654 (Fed. Cir. 2000), it was held that "while the references need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability must be "clear and particular." In re Dembicczak, 175 F.3d at 999, 50 USPQ2d at 1617. [Emphasis added]. In the instant office action, the showing of combinability is far from "clear and particular."

"For a proper obviousness combination, the prior art references must provide a suggestion or motivation to make such a combination."

Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 168, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) citing Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 934 15 USPQ2d 1321, 1323 (Fed. Cir. 1990).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys. Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* Applicant, thereby, contends that there is no suggestion or incentive to combine Edelson with Dionne et al. because there is no suggestion or incentive to combine the references.

Thus, for a obviousness combination, the "critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the combination.'" *Fromson v. Advance Offset Place, Inc.*, 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) quoting *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1453, 1452, 221 USPQ 481, 488 (Fed. Cir. 1984). In other words, the "mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) citing *Carl Schenck, A.G. v. Nortron Corp.*, 713 F.2d 782, 787, 218 USPQ 698, 702 (Fed. Cir. 1983). The Edelson reference relates to a mattress, mat, couch, or ottoman having four rectangular cushion sections that are flexibly interconnected along certain of their top and bottom edges by hinges so that the mattress-like article can be folded and compactly stored.

Dionne includes no teaching or even suggestion that the golf mat be used as a yoga mat, or include symmetrical body placement guide on the upper surface thereof configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. In fact, Applicant believes that it would be patently absurd to utilize such a golf mat in a yoga setting. Edelson does not suggest the desirability of a combination with Dionne because any such suggestion that Edelson should be modified comes solely from Applicant's own disclosure. Accordingly, Edelson does not suggest to one skilled in the art the desirability to use a body alignment guide.

Furthermore, the "statute, §103, requires much more, i.e., that it would have been obvious to produce the claimed invention at the time it was made without the benefit of hindsight." *Orthokinetics, Inc. v. Safety Travel, Chairs, Inc.*, 806 F.2d 1565, 1575, 1 USPQ2d 1081, 1087 (Fed. Cir. 1986). "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself."

Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) citing *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 & n.14, 221 USPQ 929, 933 & n.14 (Fed. Cir. 1984).

Applicant believes the motivation to combine Edelson with Dionne et al. derived from Applicant's invention since there is no suggestion in the cited references for the desirability of such a combination.

The Office Action fails to provide anything more than a conclusory statement that Dionne discloses indicia positioned from the longitudinal axis at a 45° angle. The golf mat of Dionne is devoid of such structure. The

Examiner attempts to ignore this by stating that the difference between the lines of Dionne forming 90 angles and the indicia of the instant claims being positioned from the longitudinal axis at a 45° angle are a mere ornamental change. As is fully described in the Specification, the body alignment guide and patterns described in the claims are no mere ornamentation, but serve a function. The Dionne reference includes no discernable indicia or lines positioned at 45° angles from either the horizontal or vertical center lines 40 and 42.

In response to Applicant's arguments, the Office Action stated:

The applicant should note that a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

With all due respect, the Examiner fails to understand that the body placement guide and patterned design are elements of the claims and serve a function rather than being mere ornamentation, as is described in detail in the Specification. MPEP 1504.01(c) [Lack of Ornamentality] clearly states:

An ornamental feature or design has been defined as one which was 'created for the purpose of ornamenting' and cannot be the result or 'merely a by-product' of functional or mechanical considerations. *In re Carletti*, 328 F.2d 1020, 140 USPQ653, 654 (CCPA 1964).

The body alignment guide and patterned designs are no mere ornamentation and are entitled to consideration as claimed elements. See *In re Dembicza*, 50 USPQ2d 1614 (Fed. Cir. 1999) (orange trash bag claiming facial indicia giving the appearance of a jack-o'-lantern); *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001) (baseball with finger placement indicia).

The Office Action further stated:

Furthermore, a mere arrangement of printed matter, though seemingly a 'manufacture,' is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969), *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). See MPEP 706.03(a).

Applicant is confused by the Office Action's apparently erroneous reference to this paragraph taken from MPEP 706.03(a) as it relates to a rejection based on 35 USC 101 and not 35 USC 103. Furthermore, the 'printed matter' referred to in the MPEP is in no way related to either the body placement guide or patterned design of the instant application.

MPEP 706.02(j) [Contents of a 35 USC 103 Rejection] clearly spells out the criteria an Examiner must meet in order to issue a rejection under 35 USC 103:

35 USC 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 USC 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) *an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.*

To establish a prima facie case of obviousness, three basic criteria must be met. *First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations.* The teaching or suggestion to make the claimed combination and

reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143-2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Capp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP 2144-2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n.3 (CCPA 1970).

It is important for an examiner to properly communicate the basis of a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.

Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 USC 282) and constitute a property right (35 USC 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (See MPEP 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application. [emphasis added]

The Office Action failed to provide a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done and the Office Action has failed to provide such a suggestion. As stated in MPEP 2143.01

[Suggestion or Motivation to Modify the References]:

The mere fact that references can be combined or modified does not render does not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Office Action failed to properly communicate the basis of the rejections so that the issues could be identified early and the Applicant given fair opportunity to reply. Thus, the rejections were procedurally improper.

Therefore, because Applicants contend that the combination of Edelson and Dionne et al. was both substantively and procedurally improper, Applicants respectfully request reconsideration and withdrawal of the rejections to Claims 1-22 under 35 U.S.C. § 103(a).

FINALITY

The finality of the Office Action should be withdrawn. In the previous office action, dated October 09, 2001, the rejections of Claims 1-22 were procedurally inadequate, as described above. The instant Office Action did not even attempt to compensate for this procedurally inadequacy by at least citing a motivation or suggestion to combine the references. The instant Office Action merely incorporated by reference the rejections from the earlier office action. The Office Action failed to provide a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The initial burden was on the Examiner to provide some suggestion of the desirability of doing what the inventor has done and the Examiner failed to do so. When an Office Action fails to properly communicate the basis of a rejection so that the issues are identified early and the Applicant given fair opportunity to reply, the rejection is procedurally improper. The Office Action failed to state the specific or implied basis for the alleged suggestion in Edelson or Dionne et al. that Edelson could be

modified. MPEP 2143.01 requires the Examiner to provide a basis for combining the references. To date, the Examiner has not done so. Therefore, it was improper for the Examiner to make the instant office action final. Applicants respectfully request reconsideration and withdrawal of the finality of the instant office action.

INTERFERENCE

Applicant respectfully requests the U.S. Patent and Trademark Office to declare an interference between the instant application and Marquez, pursuant to MPEP 2306, 2309 or whichever section of the MPEP the Examiner deems appropriate under the circumstances. Applicant claims the same patentable invention as is claimed in Marquez. A copy of Marquez is submitted herewith as part of an Information Disclosure Statement.

New Claim 23 substantially corresponds to claim 9 of Marquez (US 6,387,013), filed March 3, 2000 and issued May 14, 2002. The instant application was filed January 19, 2001 and claims priority from provisional application Serial No. 60/177,512, filed January 21, 2000; and provisional application Serial No. 60/229,868, filed August 30, 2000.

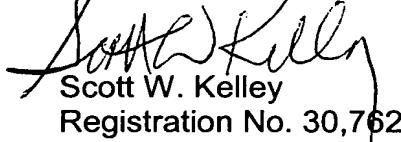
The subject matter of Claim 23 was fully disclosed in the figures, specification, and claims of the instant application, as originally filed. No new matter was added.

CONCLUSION

Applicant believes that the foregoing amendments and argument distinguish the claims of the present invention from the prior art references. Accordingly, Applicant believes that all pending claims 1-23 are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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CLEAN VERSION OF ALL PENDING CLAIMS

The following is a clean version of the entire set of pending claims. In accordance with 37 CFR 1.121 (c)(1)(ii),

1. A yoga mat, comprising:

an elongated mat having an upper surface and a lower surface; and
a symmetrical body placement guide³⁰ on the upper surface of the mat

intended use (and configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures, the body placement guide including:

(col 32 line 67, col 4 line 21-22) a patterned design, defining a longitudinal axis substantially extending the length of and bisecting the upper surface, the patterned design further defining a transverse axis bisecting the longitudinal axis, and indicia positioned from the longitudinal axis at a forty-five degree angle; and
four equal quadrants^(col 4 line 23) defined by the longitudinal axis and the transverse axis, each quadrant being adjacent to two other quadrants, the patterned design in each quadrant being a mirror image of the patterned design of the two adjoining quadrants.

Fig 1
3a-3b
4a-4b
6-8

3. The yoga mat of claim 1, wherein the indicia comprises a line⁽⁴⁰⁾ extending from the longitudinal axis at a forty-five degree angle. 12

4. The yoga mat of claim 1, wherein the patterned design includes indicia positioned from the transverse axis at a forty-five degree angle.

5. The yoga mat of claim 4, wherein the indicia comprises a line extending from the transverse axis at a forty-five degree angle.

6. The yoga mat of claim 1, wherein the patterned design defines multiple segments of equal area parallel to the transverse axis. 13

7. The yoga mat of claim 1, wherein the patterned design defines multiple segments of equal area parallel to the longitudinal axis. 14

Figs
3a-4b
6-8

8. The yoga mat of claim 1, wherein the patterned design includes step indicia within each quadrant. 13

9. The yoga mat of claim 8, wherein the step indicia are created by intersecting lines forming a ninety degree angle. 16

10. The yoga mat of claim 1, wherein the elongated mat has a rectangular configuration.

Figs
CRS
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11. A yoga mat, comprising:
an elongated mat having an upper surface and a lower surface; and
a symmetrical body placement guide on the upper surface of the mat
and configured to aid a yoga practitioner to properly align the practitioner's
body during yoga postures, the body placement guide including:

a patterned design defining a longitudinal axis substantially extending
the length of and bisecting the upper surface, the patterned design further
defining a transverse axis bisecting the longitudinal axis; and

four equal quadrants defined by the longitudinal axis and the
transverse axis, each quadrant being adjacent to two other quadrants, the
patterned design in each quadrant being a mirror image of the patterned
design of the two adjoining quadrants; 1

wherein the patterned design includes indicia positioned from the
longitudinal axis at a forty-five degree angle; and 1

wherein the patterned design includes indicia positioned from the
transverse axis at a forty-five degree angle. 5

12. The yoga mat of claim 11, wherein the indicia extending from the
longitudinal axis and transverse axis at a forty-five degree angle comprise
lines.

13. The yoga mat of claim 11, wherein the patterned design defines
multiple segments of equal area parallel to the transverse axis.

14. The yoga mat of claim 11, wherein the patterned design defines multiple segments of equal area parallel to the longitudinal axis.

15. The yoga mat of claim 11, wherein the patterned design includes step indicia within each quadrant.

16. The yoga mat of claim 15, wherein the step indicia are created by intersecting lines forming a ninety degree angle.

17. The yoga mat of claim 1, wherein the elongated mat has a rectangular configuration. *cl 10*

18. A yoga mat, comprising:

an elongated mat having a rectangular configuration, an upper surface and a lower surface; and

a symmetrical body placement guide on the upper surface of the mat and configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures, the body placement guide including:

a patterned design defining a longitudinal axis substantially extending the length of and bisecting the upper surface, the patterned design further defining a transverse axis bisecting the longitudinal axis; and

four equal quadrants defined by the longitudinal axis and the transverse axis, each quadrant being adjacent to two other quadrants, the patterned design in each quadrant being a mirror image of the patterned design of the two adjoining quadrants; \

wherein the patterned design includes indicia positioned from the ³ longitudinal axis at a forty-five degree angle;

wherein the patterned design includes indicia positioned from the ⁴ transverse axis at a forty-five degree angle; and

wherein the patterned design includes step indicia within each quadrant. ⁸

19. The yoga mat of claim 18, wherein the indicia extending from the longitudinal axis and transverse axis at a forty-five degree angle comprise lines. 4/5

20. The yoga mat of claim 18, wherein the patterned design defines multiple segments of equal area parallel to the transverse axis. 6

21. The yoga mat of claim 18, wherein the patterned design defines multiple segments of equal area parallel to the longitudinal axis. 7

22. The yoga mat of claim 18, wherein the step indicia are created by intersecting lines forming a ninety degree angle. 9

23. A yoga mat, comprising: *new subj. matter*
a mat comprised of a flat structure having an upper surface, a lower surface and a longitudinal axis;
a first center line positioned upon said upper surface of said mat;
a second center line positioned upon said upper surface of said mat parallel to said longitudinal axis and orthogonal with respect to said first center line, wherein said second center line intersects said first center line;
a plurality of first lines parallel to said first center line;
a plurality of second lines parallel to said second center line;
wherein said first center line, said second center line, said plurality of first lines and said plurality of second lines provide a plurality of rectangles upon said mat, *wherein said plurality of rectangles are separated into six non-overlapping sets of four quadrants defining a unit area on opposing sides of said second center line wherein each set of said four quadrants has a center point; and* (12-11)
[a plurality of markers wherein a single marker is located on selected intersections of said plurality of second lines with said first line and at each said center point of each set of four quadrants.]